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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLIFTON LIND, GARY L. LOEBIG, JEFFERSON C. LIND, and JOSEPH R. ENZMINGER

Appeal 2009-002500
Application 10/808,914
Technology Center 3700

Decided: October 20, 2009

Before ERIC GRIMES, FRANCISCO C. PRATS, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a system and method for playing a bingo-type game, which the Examiner has rejected as being anticipated and including new matter. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

The Specification discloses an electronic bingo game "played with bingo card representations each stored as a data structure or data record defining a predefined arrangement" of numbers or other "game designations" (Spec. 3: 18-20). "Players participate in [the] bingo-type games . . . through player stations each having a suitable player interface" (*id.* at 4: 8-9). "[D]aubing may be performed manually by the player . . . [or] automatically . . . in response to an automatic daub input made by the player" (*id.* at 4: 11-14). "Daubing" refers to marking designations on a card as they are selected during the game (*id.* at 2: 10-11).

In the bingo game method disclosed in the Specification, a "matched card set" is made by matching each one of a set of bingo card representations to a "game designation set" (*id.* at 15: 15-19), which is the set of numbers (or other game designations) selected for a particular bingo game (*id.* at 6: 15-21). The matched card set includes a number of "game play records," each of which "corresponds to a different one of the bingo card representations and is associated with a result in the bingo-type game" (*id.* at 15: 20-21). That is, each game play record in the matched card set represents a completed bingo game, and is associated with a result (e.g., win or lose) that "is determined by the pattern in which the game designation set for the particular game match[es] the card designations associated with the corresponding bingo card representation" (*id.* at 15: 3-6).

Claims 2, 3, 7-9, and 12-19 are pending and on appeal. Claims 16 and 19 are representative and read as follows:

16. A gaming system for conducting bingo-type games, the gaming system including:

(a) a player station;

(b) a user interface included with the player station, the user interface for (i) enabling a player using the player station to enter a game play request for a play in a bingo-type game to initiate a game play request communication from the player station, and for (ii) enabling the player to enter an automatic daub input for the play in the bingo-type game as a separate input after entry of the game play request;

(c) a data storage device for storing a matched card set, the matched card set including a number of game play records, each game play record corresponding to a respective bingo card representation and including a result indicator indicating a result of a match between the respective bingo card representation and a set of game designations;

(d) a back office system connected for communication with the player station and also connected for communication with the data storage device, the back office system for assigning a respective game play record from the matched card set to the player station in response to receiving the game play request communication; and

(e) an automatic daub control for applying the set of game designations in response to the automatic daub input to automatically daub the respective bingo card representation associated with the respective game play record assigned to the player station.

19. A method for conducting a bingo-type game, the method including the steps of:

(a) storing a matched card set at a data storage device, the matched card set including a number of game play records, each game play record corresponding to a respective bingo card representation and including a result indicator indicating a result of a match between the respective bingo card representation and a set of game designations;

(b) receiving a game request from a player in the bingo-type game;

(c) assigning a respective game play record to the player in response to receiving the game play request;

(d) receiving an automatic daub input from the player in the bingo-type game, the automatic daub input being a separate input after entry of the game play request; and

(e) in response to the automatic daub input, applying the set of game designations to automatically daub the respective bingo card representation associated with the respective game play record assigned to the player.

NEW MATTER

Issue

The Examiner has rejected claims 2, 3, 7-9, and 12-19 under 35 U.S.C. § 112, first paragraph, on the basis that the Specification does not describe an automatic daub input that is separate from a game request input (Ans. 3). The Examiner reasons that the "specification (paragraph 0057) states that the automatic daubing is enabled in response to some input by the player. It does not specify that the input must be separate from the game request input." (*Id.*)

Appellants contend that the Specification describes three daubing alternatives, including an automatic daub input entered separately from a game request input, as recited in the claims (Appeal Br. 8). Appellants also contend that the Specification describes a game play request that represents a request for automatic daubing as a different alternative (*id.* at 8-9), which "makes it even more clear that the previously described automatic daub input is an input separate from the game play request" (*id.* at 8).

The issue with respect to this rejection is: Have Appellants shown that the Examiner erred in finding that the Specification does not describe an automatic daub input that is separate from a game request input?

Findings of Fact

1. The Specification states that a "player at the player station may manually daub his or her bingo card or cards using a touch screen display. . . . Alternatively, the player stations 40 may include a control that automatically daubs a player's card(s) in response to some automatic daub input entered at the player station." (Spec. 24: 20 to 25: 2.)

2. The paragraph quoted in FF 1 corresponds to paragraph 0057 in the application as published (US 2004/0176169 A1, published Sept. 9, 2004).

3. The Specification states that "[a]lternatively to daubing the card representation at player station 40, the player may rely on the matching of designations performed in the back office system. . . . In this mode of play, the request for a play entered by the player at player station 40 represents a request for automatic daubing." (Spec. 25: 3-6.)

Principles of Law

The Examiner "'bears the initial burden . . . of presenting a prima facie case of unpatentability.' Insofar as the written description requirement is concerned, that burden is discharged by 'presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.'" *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996), quoting *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

"If . . . the specification contains a description of the claimed invention, albeit not *in ipsis verbis* (in the identical words), then the examiner . . . , in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient." *Alton*, 76 F.3d at 1175.

Analysis

The Specification expressly describes an embodiment of the disclosed bingo game method in which a player's card is automatically daubed in response to an automatic daub input entered by the player. The Specification does not expressly state that the automatic daub input is separate from the game request input in this embodiment, but it also does not state that the game request input is a request for automatic daubing. By contrast, in the embodiment in which the daubing is performed in the back office system, the Specification expressly states that the game play request represents a request for automatic daubing.

Thus, the Specification describes one embodiment in which automatic daubing is an alternative to manual daubing that a player can invoke using an automatic daub input, and describes a *different* daubing alternative in which a game play request represents a request for automatic daubing. In view of this disclosure, the Examiner has not adequately explained why one of ordinary skill in the art would not recognize the first embodiment of automatic daubing as a description of an automatic daub input that is separate from a game play request.

Conclusion of Law

Appellants have shown that the Examiner erred in finding that the Specification does not describe an automatic daub input that is separate from a game request input.

ANTICIPATION

Issue

The Examiner has rejected claims 2, 3, 7-9, and 12-19 under 35 U.S.C. § 102(b) as anticipated by Itkis[1] (Ans. 3). The Examiner finds that Itkis discloses a gaming system that meets all of the limitations of the instant claims, including "a data storage device (43) for storing a matched card set that includes a number of game play records[, each] game play record including a respective bingo card representation and a result indicator indicating a result of a match between the respective bingo card representation and a set of game designations. (Col 5, 15-23)." (*Id.* at 4.) The Examiner also finds that Itkis' system includes "a back office system (1) . . . [that] assigns a respective game play record from the matched card set to the player station in response to receiving the game play request communication. (Abstract)." (*Id.*)

Appellants contend that Itkis' system and method do not include a "matched card set" or "any component that assigns game play records (including a result indicator) from a matched card set in response to receipt of a game play request," as recited in parts (c) and (d) of claim 16, and in the other independent claims (Appeal Br. 11).

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[1] Itkis, U.S. Patent 4,856,787, issued Aug. 15, 1989.

The issue with respect to this rejection is: Have Appellants shown that the Examiner erred in finding that Itkis' system (a) includes the data storage device recited in the instant claims, and (b) assigns a game play record to a player in response to a game play request?

Additional Findings of Fact

4. Itkis discloses "a distributed game network comprising a master game device and a number of slave game devices" (Itkis, col. 1, ll. 41-43).

5. Itkis discloses that "the master game device 1 is used by a game operator, slave game device 7 is utilized by a player" (*id.* at col. 2, ll. 63-65).

6. Itkis discloses that the "slave game devices execute in real time (play) concurrently a number of menu-selectable card and chance games, such as bingo, keno, poker, blackjack, and the like" (*id.* at col. 1, ll. 50-53).

7. Itkis discloses that "the master game device 1 transmits to the slave game devices 7 the bingo pattern 23 and the called bingo numbers 30 (the numbers called by the game operator). The called bingo numbers 30 are marked in the cards 21 . . . by crosshatching the matching number." (*Id.* at col. 3, ll. 55-60.)

8. Itkis discloses that "if the slave game device 7 determines that a bingo or keno game has reached the winning stage, the master 1 is immediately notified via the network 6; so that the respective game can be stopped by the game operator for verification of the winning" (*id.* at col. 4, ll. 3-7).

9. Itkis discloses that "the above description presumes that the game operator merely repeats and enters in the master game device 1 . . . the bingo or keno numbers drawn in a conventional way. Yet, a conceivable variation

of the technique is the utilization of a random number generator built-in to the master game device." (*Id.* at col. 4, ll. 16-21.)

10. Itkis discloses that "the slave game device provides two modes of playing the bingo game, namely the automatic mode 39 and the manual mode 40" (*id.* at col. 4, ll. 47-49).

11. Itkis discloses that "[i]n the automatic mode 39, the player only enters (via the touch screen display 9) the bingo card identification number (ID); the rest of the monitoring of the current status of the game is automatically done by the slave game device 7" (*id.* at col. 4, ll. 49-54).

12. Itkis discloses that the input/output (I/O) configuration of the slave game device 7 can be expanded to include electronic card reader and writer 36 (*id.* at col. 4, ll. 33-39), which "serves as the interface with the smart game card 42 . . . [which] has a built-in microprocessor 43" (*id.* at col. 5, ll. 9-14).

13. "The microprocessor 43 keeps track of all the transactions made with the help of the card 42 including bets and outcomes of games. Also, the microprocessor 43 stores game specific information, such as the bingo or keno game card contents, or the game card identification number" (*id.* at col. 5, ll. 15-20).

14. Itkis discloses that the "game device 7 writes to the card 42 outcomes of the bets and reads from the microprocessor 43 the current account balance and the game card identification number" (*id.* at col. 5, ll. 26-28).

Principles of Law

"[I]n an *ex parte* proceeding to obtain a patent . . . the Patent Office has the initial burden of coming forward with some sort of evidence tending to disprove novelty." *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt,* 211 F.3d 1367, 1372 (Fed. Cir. 2000).

Analysis

Itkis does not disclose that its system selects a game designation set, meaning the designations representing a complete bingo game, and matches that set of designations to a group of bingo card representations, thus producing a set of game play records that are each associated with a result, as recited in the instant claims.

Rather, Itkis discloses that its system executes a conventional bingo game by generating bingo numbers and communicating them in real-time from the master game device to the slave game devices. The slave game devices monitor the current status of the game and notify the master game device of a winning pattern, so that the game can be stopped by the game operator and the winning numbers verified.

Thus, the claimed system and Itkis' system function in fundamentally different ways. In the claimed system, the "winning" or "losing" status of a

given card is known at the time it is assigned to a player in response to the game play request; i.e., the game play record is associated with a result indicator. Itkis' system, by contrast, plays out the bingo game in real-time and the "winning" or "losing" status of any particular card is not known until a winning combination of numbers has been drawn. As a result, Itkis' system does not comprise a matched card set that includes game play records, and does not assign a game play record to a player in response to a game play request.

Conclusion of Law

Appellants have shown that the Examiner erred in finding that Itkis' system includes the data storage device recited in the instant claims and in finding that Itkis' system assigns a game play record to a player in response to a game play request.

SUMMARY

We reverse the rejection of claims 2, 3, 7-9, and 12-19 for lack of adequate written description and anticipation.

REVERSED

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